

## **REMARKS**

The Office Action dated November 18, 2008, has been received and reviewed. This response, submitted along with a Request for Continued Examination (RCE) and a Petition for a One-Month Extension of Time, is directed to that action.

Claims 1 and 4 have been amended. Support for the amendments can be found in paragraphs [0019] and [0020] of the published application, US 2006/0057366 A1. No new matter has been added.

The applicants respectfully request reconsideration in view of the foregoing amendments and the following remarks.

### **Claim Objections**

The Examiner objected to claim 4 for being dependent upon a cancelled claim. Claim 4 has been amended herein to correct this informality, thus obviating the objection.

### **Claim Rejections- 35 U.S.C. §102**

The Examiner rejected claims 1, 3-9 and 11-16 under 35 U.S.C. §102(b) as anticipated by Buccellato et al. (WO 98/24978 as evidenced by US 6,861,141). The applicants respectfully traverse this rejection.

The applicants respectfully submit that Buccellato fails to teach all of the limitations of the presently claimed invention, particularly a pressure sensitive adhesive (PSA) having a glass transition temperature of 30°C or higher and a bond strength in a tolerance range of  $\pm 15\%$  in a peel-rate range of 0.1 cm/min to 100 m/min. With respect to the glass transition temperature, Buccellato specifically teaches that “[p]referred adhesive compositions have a  $T_g$  ranging from between about -25°C to about +10°C.”(col. 2, lines 27-28).

The bond strength limitation in the presently claimed invention is a function of the PSA's ability to be released from a substrate and then parted again with a consistent application of force, independent of peel rate—reversibility. This limitation is not taught in Buccellato, nor would it be expected because Buccellato is directed to a permanent pavement marking adhesive, and these adhesives are clearly not reversible. Rather, pavement adhesives are formulated specifically to remain fixed and permanent on the pavement surface.

Although the presently claimed invention contains limitations relating to the PSA's underlying physical properties, the applicants submit that it is often the case that polymer compositions cannot be defined by structure alone. Indeed, both structure *and* function are often need to properly define the invention. In this respect, the applicants suggest that it may be helpful for the Examiner to consider the decision in *E. I. DuPont v. Phillips Petroleum*, 849 F.2d 1430, 7 USPQ2d 1129 (Fed. Cir. 1988). In particular, Applicants call the Examiner's attention to the discussion in section I. B. of the decision, relating to the novelty of claims 1 and 12. For the Examiner's information, claims 1 and 12 of the involved patent are reproduced below:

- “1. An interpolymer composed of interpolymerized comonomers consisting essentially of ethylene and at least one normal aliphatic monoolefinic hydrocarbon containing from 5 to 10 carbon atoms per molecule, the proportion of said monoolefinic hydrocarbon being from 3 to 7% of the weight of the interpolymer, *said interpolymer having* a melt index within the range of 0.3 to 20, and, when in the form of a film, *an Elmendorf tear strength in the range of 150 to 400 grams per mil*, and a density of 0.93 to 0.94.
  
- “12. Composition of claim 5 in the form of pipe which is further *characterized by withstanding 3000 hours at*

**hoop stress** [= impact strength] of 750 psi and a temperature of 60°C. [Emphasis added.]”

As noted by the Court:

“Those two claims include a limitation not present in the other four claims and not conceded by Du Pont to be present in the Witt and Leatherman copolymers. Claim 1 includes this limitation: ‘when in the form of a film, ***an Elmendorf tear strength*** in the range of 150 to 400 grams per mil.’ Claim 12, which claims the polymer in the form of pipe, recites a limitation to ***impact strength in terms of hoop stress***. [Again, emphasis added.]”

The Court held that a finding of anticipation **requires** that these functional limitations be found in the prior art. According to the Court, “[t]o find anticipation of claims 1 and 12, the district court **must** determine that Phillips met its burden of providing by clear and convincing evidence that the copolymers it made prior to Du Pont’s invention **possessed those properties**. [Again, emphasis added.]”

By way of explanation, the Court noted that there are instances, particularly where polymers are involved, where it is appropriate to define the invention in terms of **both structure and function**. See *Du Pont*, 849 F.2d at 1435 (“On occasion, particularly with polymers, structure alone may be inadequate to define the invention, making it appropriate to define the invention in part by **property** limitations.”)

The Court found that the invention involved in *Du Pont* was properly defined in terms of both structure and function, the function being the particular tear strength limitation of claim 1 or the impact strength limitations of claim 12. According to the Court, “[t]he issue is whether the claimed copolymer, ***as defined in part by various property parameters***, is new.

\* \* \* Phillips must prove on remand that ***the strength limitations*** of claims 1 and 12 ***are possessed*** by the Witt and Leatherman products. [Again, emphasis added.]”

Applicants respectfully submit that the present case is analogous to the situation in *Du Pont*. Like *Du Pont*, the instant PSA's are properly defined in terms of both structure and function since structure alone is insufficient to properly define the invention. Like *Du Pont*, the instant dosage forms are properly defined in terms of glass transition temperatures and bond strength in a tolerance range of  $\pm 15\%$  in a peel-rate range of 0.1 cm/min to 100 m/min. And, like *Du Pont*, anticipation or obviousness requires that the Examiner prove that the prior PSA's possessed these limitations; in other words, the newly added claim limitations cannot be ignored.

Based on the foregoing reasons, the applicants submit that Buccellato does not teach all of the limitations of the presently claimed invention, and respectfully request that the Examiner withdraw this rejection.

#### Claim Rejections- 35 U.S.C. §103

The Examiner rejected claims 4, 10 and 12 under 35 U.S.C. §103(a) as obvious over Buccellato; and claims 17 and 18 as obvious over Buccellato in view of McLaughlin et al. (US 6,365,793). The applicants respectfully traverse this rejection.

The applicants submit that a person of ordinary skill in the art would not be motivated to prepare a PSA having the glass transition temperature and bond strength characteristics of the presently claimed invention after reading Buccellato because Buccellato is directed to a completely different type of PSA. Indeed, modifying Buccellato to achieve the presently claimed PSA would render Buccellato unsuitable as a permanent pavement marker. As espoused by the Federal Circuit, if a proposed modification would render the prior art

invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Accordingly, a *prima facie* case of obviousness cannot be established, and the applicants respectfully request that the Examiner withdraw these rejections.

The Examiner also rejected claims 1, 3-12, and 16-18 under 35 U.S.C. §103(a) as obvious over Bennett et al. (WO 95/13328) in view of McLaughlin; and claims 13-15 as obvious over Bennett in view of McLaughlin and further in view of Buccellato. The applicants respectfully traverse these rejections.

Like Buccellato, discussed above, Bennett also is directed to a PSA having a low glass transition temperature. In particular, Bennett teaches that the glass transition temperature of his resulting polymer “has a value between -45°C and 15°C”. (col. 3, lines 16-22). There is no reason why the skilled artisan would be motivated to prepare an adhesive with a glass transition temperature well outside of Bennett’s range (i.e. greater than 30 °C) as in the presently claimed invention.

Moreover, Bennett again is a permanent adhesive, as understood by the disclosure of the peel strength, adhesion and solubility parameters. There is no reason why the skilled artisan would look to a permanent adhesive reference when looking to prepare a reversible adhesive. Indeed, there is nothing that would even suggest as much in the disclosure of Bennett and McLaughlin, and modifying Bennett to achieve the presently claimed invention would render Bennett unsuitable for its intended use.

With respect to the rejections under 35 U.S.C. §103 over Bennett in view of McLaughlin and further in view of Buccellato, the applicants submit that the Federal Circuit’s decisions in *E. I. DuPont v. Phillips Petroleum* and *In re Gordon*, discussed supra, are again relevant.

Based on the foregoing statements, the applicants submit that a *prima facie* case of obviousness cannot be established, and respectfully request that the Examiner withdraw these rejections.

Applicants believe that the claims are in condition for allowance, and such favorable action is respectfully requested. If any issues remain, the resolution of which may be advanced through a telephone conference, the Examiner is invited to contact the applicants' attorney at the phone number listed below.

**CONDITIONAL PETITION FOR EXTENSION OF TIME**

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

**ADDITIONAL FEES**

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263

Respectfully submitted,  
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